Notice of Allowability	Application No.	Applicant(s)	
	09/721,869	KENNARD, WAYNE MARINER	
	Examiner	Art Unit	
	Donald L. Champagne	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to *BPAI decision mailed 21 November 2005*.

2. ☒ The allowed claim(s) is/are *1-10*.

3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
   a) ☐ All b) ☐ Some* c) ☐ None of the:
      1. ☐ Certified copies of the priority documents have been received.
      2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
      3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

   * Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.

5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
   (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
      1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
   (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

   Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).

6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____ .
7. ☐ Examiner's Amendment/Comment
8. ☐ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Donald L. Champagne
Primary Examiner
Art Unit: 3622

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WAYNE MARINER KENNARD

Appeal No. 2005-2715
Application No. 09/721,869

ON BRIEF

champagne
3622

Before KRASS, RUGGIERO and LEVY, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

Decision On Appeal

This is a decision on appeal from the final rejection of claims 1-10.

The invention pertains to the redeeming of mileage awards by award program participants. In particular, mileage awards are redeemed when the accumulated award mile total is less than the required number of award miles necessary to redeem a set or posted award.

Representative independent claim 1 is reproduced as follows:

1. A computer-based method for maximizing redemption award units in an award program, the method for implementation in a system that includes at least a central processing unit ("CPU"), an input/display device under at least partial CPU control, and a storage device at least under partial CPU control, the method comprising the steps of:

(a) storing in the storage device at least one predetermined award unit level for which the award program will issue an award program participant an award;

(b) storing in the storage device a shortfall percentage;

(c) each award program participant being permitted to accumulate a number of award units earned by performing acts under the award program for which predetermined numbers of award units will be awarded;

(d) inputting with the input/display device into the system the number of award units accumulated at step (c) for each award program participant;

(e) storing separately in the storage device for each of the award program participants the number of accumulated award units input at step (d);

(f) redeeming an award program award including the substeps of,

(1) retrieving from the storage device a predetermined award unit level for which a participant may redeem accumulated award units to receive a particular award;

(2) retrieving from the storage device the accumulated award unit total for an award program participant requesting to redeem an award according to the predetermined award unit level stored in the storage device at step (a);

(3) comparing under CPU control the retrieved predetermined award unit level with the retrieved accumulated award unit total for an award program participant requesting to

redeem the award, and determining if the retrieved accumulated award unit total is less than the retrieved predetermined award unit level, and if retrieved accumulated award unit total is less than retrieved predetermined award unit level go to substep (f)(4);

(4) determining under CPU control if the retrieved accumulated award unit total is equal to, or greater than the shortfall percentage multiplied by the retrieved predetermined award unit level, and if retrieved accumulated award unit to is equal to, or greater than, the product of the retrieved accumulated award unit total multiplied by the predetermined award unit level go to step (f)(6);

(6) determine under CPU control a number of award units that the retrieved accumulated award unit total is less than the predetermined award unit level;

(7) under CPU control multiplying the number of award units that the retrieved accumulated award unit total is less than the predetermined award unit level by a multiplication factor and determining a monetary amount; and

(8) redeeming an award based on a redemption of the retrieved accumulated award unit total with the monetary amount determined a substep (f)(7).[1]

The examiner relies on the following reference:

Anderson et al. (Anderson) US 2002/0065723 May 30, 2002

Claims 1-10 stand rejected under 35 U.S.C. § 103 as unpatentable over Anderson.

Reference is made to the briefs and answer for the respective positions of appellant and the examiner.

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[1] We note that there does not appear to be a step "(5)" in the claim.

OPINION

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). To reach a conclusion of obviousness under §103, the examiner must produce a factual basis supported by a teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). The examiner may satisfy his/her burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

It is the examiner's position that Anderson teaches the claimed subject matter but for "a shortfall percentage," but the examiner concludes that it would have been obvious "to add to the teachings of Anderson...that the shortfall amount be expressed, stored and displayed as a shortfall percentage" (answer-page 4)

because "percentages are a common and convenient means for summarizing criteria" (answer-page 4).

We will not sustain the rejection of claims 1-10 under 35 U.S.C. § 103 because, in our view, the examiner has not established the requisite prima facie case of obviousness.

It is clear, from our review thereof, that Anderson is concerned with providing rewards to customers based on certain events, that a maximizer not only correlates what points a user has in a rewards program with the rewards each program has, and displays the rewards that can be earned when reaching an appropriate level of points, but the maximizer can convey to the user which items the user is "close" to being able to purchase by redeeming points (see paragraph 0027). It is also true that Anderson discloses, in paragraphs 0053 and 0054, that a conversion can be made, converting certain point types to other point types.

However, we find no disclosure or suggestion within the four corners of Anderson which indicates that any shortfall "percentage" is stored and that this shortfall percentage is then used to determine a monetary amount which can be paid in addition to an accumulated amount of points in order to achieve a certain award. We agree with appellant, at page 7 of the principal

brief, that "Anderson...just recognizes a shortfall and does nothing with the shortfall" whereas the "present invention recognizes a shortfall and then provides a novel system and method for effecting a way for the user to use accumulated miles and the purchase of additional miles according to a novel method so that the user is able to redeem an award from the benefits award program without having the required miles."

Merely because a "percentage" may be "a common and convenient means for summarizing criteria," this does not explain why the artisan would have modified anything in Anderson in order to provide for a shortfall "percentage" when none is disclosed, and then use this percentage value in determining a monetary amount a user may pay to earn an award he/she otherwise would not have been entitled to.

The examiner's decision rejecting claims 1-10 under 35 U.S.C. § 103 is reversed.

REVERSED

ERROL A. KRASS
Administrative Patent Judge

JOSEPH F. RUGGIERO
Administrative Patent Judge

STUART S. LEVY
Administrative Patent Judge

BOARD OF PATENT APPEALS AND INTERFERENCES

EK/rwk

Appeal No. 2005-2715
Application No. 09/721,869

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